



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,957	07/14/2003	Mitsushi Yamamoto	UNIU79.013AUS	6418
20995 7590 05/08/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER AHMAD, NASSER	
			ART UNIT 1772	PAPER NUMBER
			NOTIFICATION DATE 05/08/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/618,957	<b>Applicant(s)</b> YAMAMOTO ET AL.	
	<b>Examiner</b> Nasser Ahmad	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/22/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/22/2007 has been entered.

### ***Rejections Withdrawn***

2. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, made in the Office Action of 9/22/2006 has been withdrawn in view of the amendment filed on 2/22/2007.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 8 and 10-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1772

5. Claims 8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Australian AU 9640808A.

AU'808 relates to an adhesive polyester film comprising a polyester film and an adhesive coating on at least one side of the film. The adhesive comprises a carboxylic acid group-containing copolymer and one cationic polymer having pyrrolidinium rings in the main chain. When the adhesive is present on both sides of the film, the structure, as interpreted by the examiner, comprises an adhesive layer on one side and the pyrrolidinium ring containing cationic polymer on the other side. The reference mentions that the laminate exhibits excellent antistatic properties. It is also understood by the examiner that the polyester film is well known to be transparent, the acrylic based adhesive is known in the art as being transparent and the antistatic layer is also transparent, as is admitted in the instant application.

Further, the laminate would inherently exhibit the maintaining of transparency even after one-hour heat treatment at 150 degrees C.

The intended use phrases such as "for transparent conductive substrates", etc. have not been given any patentable weight because said phrases are not found to be of positive limitations.

6. Claims 8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Malhotra (5534374).

Malhotra relates to a laminate (figure-1) comprising a transparent polyester substrate (such as Mylar, which is PET) (2) with adhesive (4) on one side and antistatic layer (41)

Art Unit: 1772

on the other side. The adhesive can be acrylic-based, which are known to be transparent as admitted by the applicant in the specification, page-8. The antistatic layer comprises a binder and an antistatic agent, such as pyrrolidine acid salt compounds and would be inherently transparent as admitted by the application the specification, page-12. See col. 6, line 62-col. 7, line 10; col. 12, lines 51-63; col. 14, lines 44-46 and 65-68; and col. 30, line 21 – col. 32, line 34.

The laminate will inherently exhibit the maintaining of the transparency as discussed above.

The intended use phrases have not been given any patentable weight as discussed above.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Australian AU'808 or Malhotra.

The Australian AU'808 or Malhotra, as discussed above, discloses that the adhesive thickness is preferably 1 micron but can be of any thickness. However, both AU'808 or Malhotra fails to teach that the thickness of the adhesive layer is 3-10 microns. It would have been obvious to one having ordinary skill in the art to modify the AU'808 or

Art Unit: 1772

Malhotra reference by providing the adhesive thickness to be 3-100 microns, based on optimization through routine experimentation, for optimum adhesiveness

### ***Response to Arguments***

9. Applicant's arguments filed 2/22/2007 have been fully considered but they are not persuasive.

Applicant argues that AU 9640808A reference *teaches that, without exception, the disclosed adhesive polyester film always has a magnetic recording layer and/or a printed ink layer, which are not transparent*. This is not found to be convincing because, as applicant correctly noted, the AU'808 reference teaches that the polyester film has a magnetic layer and/or printed ink layer. However, applicant should note that the magnetic layer and/or the printed ink layer does not cover the entire surface. Hence, the adhesive polyester film is not "not transparent" as alleged because, for example the areas not covered by the magnetic layer and/or the printed layer would not be not transparent.

Responding to applicant's arguments that AU'808A indicates that *a white pigment in the polyester film is preferred*, applicant is informed that said presence of a white pigment is directed to a preferred embodiment. Further, the presence of the white pigment does not render the film non-transparent as alleged. The presence of a white pigment can reduce the transparency.

Art Unit: 1772

Applicant's argument that the probability/possibility of the presence of the white pigment in the polyester film of AU'808A makes the film non-transparent is not deemed to be convincing because, as explained hereinabove, the presence of said pigment can reduce the transparency but make the film non-transparent as opined by the applicant. Regarding applicant's argument for Malhotra, applicant is informed that, contrary to the allegation, applicant has failed to show that Malhotra does not comprise a polymer of 20-30 carbon atoms with repeating units, secondly, the claims does recite that the main contains a number of repeating pyrrolidinium rings, and said limitation cannot be read thereinto for the purpose of avoiding the applied prior art. As for the 35 USC 103(a) rejections, the above explanations apply *a fortiori* herein.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 4/30/07  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
April 30, 2007.